# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/489,576 | 01/21/2000 | William J. Baer | STL000013US1 | 6006 |

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| 23373 | 7590 | 01/11/2005 | | |

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| EXAMINER |
|---|
| NGUYEN BA, PAUL H |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2176 | |

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | | Application No. | Applicant(s) |
|---|---|---|---|
| **Office Action Summary** | | 09/489,576 | BAER ET AL. |
| | | Examiner | Art Unit |
| | | Paul Nguyen-Ba | 2176 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *12/10/2004*.

2a)☒ This action is **FINAL.**  2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-51* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

## DETAILED ACTION

### *Notice to Applicant*

1.    This action is responsive to Applicant's Response under 37 C.F.R. § 1.111 filed on

December 10, 2004.

2.    Claims 1-51 are currently pending.  Claims 1, 6, 16, 21, 31, and 36 are independent

claims.

### *Claim Rejections - 35 USC § 103*

3.    The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains.  Patentability shall not be negatived by the
> manner in which the invention was made.

4.    Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw-

Hill Primis Custom Publishing ("McGraw") (www.mhhe.com/primis), archived circa 1998, via

the Wayback Machine (www.archive.org).

**Independent Claims 1, 6, 11, 16, 21, 31, 36 and**

**Dependent Claims 4, 11, 19, 26, 34, 41, 49, 50, 51**

McGraw teaches a method, system, and a program storage device readable by a machine

for creating custom published textbooks (*compare with* "books") corresponding to the each

particular user's needs, teaching technique, style, *content*, and *organization* (see pg. 1).

Primis database (*compare with* "data repository") is a custom publishing database that

contains a collection of modular, stand-alone text files (*compare with* "second plurality of

content entities of a second hierarchically structured content object") (see pg. 3 → includes

textbooks, supplements, journals, magazine articles, lab manuals, case studies, literary works,

and historical documents each structured such that the content entities rank or grade in a

subordinate manner in a "hierarchy;" see pgs. 5-12 → i.e. discipline, volume, chapter, section,

etc.) that can be mixed and matched *in any order* (*compare* with "order selected by a user") and

seamlessly arranged to create a custom book (*compare with* "first hierarchically structured

content object") consisting of the selected modular text files (*compare with* "first plurality of

content entities") (see pg. 3).

Each of the "content entities" of the first and second objects has identifiers (see pgs. 5-9,

and 12 → each content identity is identified by a unique title or name, a unique URL, and a

unique Item Identifier number).

McGraw does not specifically show defining the first object by a first list of content

entity identifiers *organized as an outline of containers such that adding the content entity*

*identifier of one of the second plurality of content entities to the first list outline adds the*

*identified content entity to the first object.*

However, McGraw teaches an "Add" hyperlink corresponding to each second object

identifier (see pgs. 7,9, and 12) for the purpose of adding the content entities of a second object

to a first object. McGraw further teaches a "Review" hyperlink for the purpose of reviewing the

contents of the first object of the custom publishing process.

It was commonly known to those of ordinary skill in the art that an "Add" hyperlink

corresponding to each second object identifier (see pgs. 7,9, and 12) exists for the purpose of

adding the content entities of a second object to a first object. It was commonly known to those

of ordinary skill in the art that a "Review" hyperlink exists for the purpose of reviewing the

contents of the first object in an outline form, showing the structure of "containers" wherein each

content entity ranks or grades, with each level subordinate to the one above (for example, see

"Microsoft Powerpoint Presentation on how to use Primis Online," (pgs. 6 and 9) cited below).

It would have been obvious at the time the invention was made to a person having

ordinary skill in the art to utilize an "Add" hyperlink corresponding to each second object

identifier (see pgs. 7, 9, and 12) for the purpose of adding the content entities of a second object

to a first object. It would have been obvious at the time the invention was made to a person

having ordinary skill in the art to utilize a "Review" hyperlink exists for the purpose of

reviewing the contents of the first object in an outline form, showing the structure of

"containers" wherein each content entity ranks or grades, with each level subordinate to the one

above

**Claims 2, 7, 17, 22, 32, 37**

McGraw further teaches *defining the second object by a second outline of containers*

(pgs. 3, 7, 9, and 12 → the available textbooks are defined in hierarchical outline form

(collection of modular text files that can be mixed and matched) → book containers, chapter

containers, etc.) or *list of content entity identifiers* (see pgs. 5-9, and 12 → each content identity

is identified by a unique title or name, a unique URL, and a unique Item Identifier number).

**Claims 3, 8, 18, 23, 33, 38**

McGraw further teaches the method, system, and a program storage device readable by a

machine wherein *adding an entity identifier from the second list or second outline container to*

*the first list adds the identified content entity to the first object* (pgs. 7, 9, 12 → the "Add"

hyperlink adds the second list or outline to the customized textbook, as discussed above).

**Claims 5, 13, 14, 20, 28, 29, 35, 43, 44**

McGraw further teaches a *user interface communicating with the data repository* (pgs. 5-

12 → i.e. Website browser communicating with Primis database), and *providing a mechanism*

*for selecting a content entity identifier or a container from the second list or second outline to*

*add to a desired location in the first list through the user interface* (pgs. 7, 9, 12 → the "Add"

hyperlink adds the second list or outline to a specified location in the customized textbook, as

discussed above).

**Claims 9, 24, 39**

McGraw further teaches the method, system, and a program storage device readable by a

machine wherein *a first container in the second outline contains on or more containers* (pgs. 3,

5-12 → "disciplines container" contains "book containers" which further contains "chapter

containers" which further contain "section containers," etc.).

**Claims 12, 27, 42**

McGraw further teaches the method, system, and a program storage device readable by a

machine wherein *the first and second objects are books* (pgs. 6, 8, 10) and the *containers are one*

*or more of a book, volume, and a chapter* (pgs 7, 9, 12).

**Claims 15, 30, 45**

McGraw further teaches *a user interface communicating with the data repository,* and

*providing a mechanism for creating a new container to add to the first outline at a desired*

*location through the user interface* (pg. 3 → allows instructors to add their own created syllabus

to the first outline at a desired location by uploading it through the user interface).

**Claims 10, 25, 40**

McGraw teaches a method, system, and a program storage device readable by a machine

as explained with respect to claims 6, 7, and 9 above, but does not specifically teach the method,

system, and the program storage device readable by a machine wherein adding the first container

to the first outline adds the content entities identified by the content entity identifiers of *all*

*containers* in the first container to the first object.

McGraw teaches the outlining of textbooks into containers for the purpose of increasing

the modularity of files for ease in creating a mixed and matched customized book (pgs. 3, 7, 9,

12).

It was commonly known to those of ordinary skill in the art that in hierarchical outlines

each level is subordinate to the one above. Therefore, it would have been obvious at the time the

invention was made to a person having ordinary skill in the art to modify the teachings of

McGraw to add the content entities identified, as well as all of the content entities' dependents

(i.e. full containers), in the first container object for the purpose of increasing the modularity of

files for ease in creating a mixed and matched customized book.

**Claims 46-48**

McGraw teaches the method, program storage device, and system wherein said first list

of content identity identifiers defining the first object comprises content identity identifier names

(see pgs. 5-9, and 12 → each content identity is identified by a unique title or name, a unique

URL, and a unique Item Identifier number), but does not specifically teach the content identity

identifier names being defined by the user.

However, McGraw teaches the compilation of a custom textbook using the instructor's

own content and materials (see pgs. 1 and 3 – 2nd paragraph) for the purpose of customizing the

textbook to the instructor's own personal preferences. It was commonly known to those of

ordinary skill in the art that an instructor can define his own work's content entity identifier for

the purpose of customizing the final textbook to the instructor's own personal preferences.

Therefore, it would have been obvious at the time the invention was made to a person

having ordinary skill in the art to allow an instructor to define his own work's content entity

identifier for the purpose of customizing the final textbook to the instructor's own personal

preferences.

## *Response to Arguments*

5.      Applicant's arguments filed December 10, 2004 have been fully considered but they are

not persuasive.

      I.      Preliminary Matter

Examiner has clarified the references made of record, but not considered pertinent to

Applicant's disclosure, below.  US Patent No. 6,091,930 and US Publication No. 2003/0050916

are correct as previously cited and correspond to their respective co-inventors as indexed on the

USPAT database system.  For the sake of clarity and to simplify matters for Applicant, however,

Examiner has changed the inventors' names to correspond to the alternate co-inventors listed on

the respective US Patent and US Patent Publication.

      II.     Arguments

Applicant first contends that there is no indication that a "customized book defined by a

first list of content entity identifiers" was commonly known to those of ordinary skill at the time

the invention was made.

To support this contention, Applicant points out that she was i) unable to locate a

"Review" hyperlink on the cited prior art, ii) assumes that Examiner meant the "View"

hyperlink, and iii) argues that the "View" hyperlink is for the purpose of viewing content of a

particular book in the database and is not for reviewing the contents of a customized book.

Examiner, however, was indeed referring to the "Review" hyperlink and <u>not</u> the "View"

hyperlink as Applicant assumed.   Examiner respectfully urges Applicant's diligence in

assessing the cited prior art and directs Applicant's attention to the circled material on the top

right corner of pgs. 8-12 of McGraw.  The "Review" hyperlink is located below the "Browse"

hyperlink and above the "Cover" hyperlink. It was commonly known and would have been obvious to one of ordinary skill in the art that the purpose of the "Review" hyperlink was to review the contents of the customized book. Furthermore, it was commonly known and would have been obvious to one of ordinary skill in the art that since the online customized book is assembled via a listing of modular parts in outline form, the contents would be reviewed in the same manner by a listing of modular parts in outline form.

Applicant next contends that Examiner's personal reasoning is insufficient to establish an obviousness rejection and that Examiner must present a *convincing line of reasoning* as to why the *artisan* would have found the claimed invention to be obvious in light of the teachings of the reference.

The hypothetical *artisan* of ordinary skill in the art would of necessity be able to understand the scientific and engineering principles applicable to the art. His knowledge resides somewhere between that possessed by a layman and that possessed by an expert, not one of ignorance. *Ex parte Hiyamizu*, 10 USPQ 2d 1393, 1394 (Bd. Pat. App. & Inter. 1988). *See also* M.P.E.P. 2141.03. It is the Examiner's opinion that a convincing line of reasoning has been laid out to show that an artisan of ordinary skill in the art would have been motivated to define a customized book by a first list of content entity identifiers in light of the "Review" hyperlink as shown in the McGraw reference.

Applicant lastly contends that Examiner has failed to establish where *a first content object stored as a first plurality of content entities is stored in a data repository.*

Assuming that Applicant's preamble carries limiting patentable weight, Examiner considers storing the first plurality of content entities in a data repository as inherent to ensure

that a user's customized entities (customized book comprised of modular parts) are stowed in

memory for immediate or later retrieval for the invention to properly function.

## *Conclusion*

6.    The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

| | | |
|---|---|---|
| US 6091930 A | 20000718 | MORTIMER, M E et al. |
| US 20030050916 A | 20030313 | ORTEGA et al. |
| US 20030140315 A | 20030724 | BLUMBERG, R E et al. |

Microsoft Powerpoint Presentation on how to use Primis Online

(http://www.mhhe.comm/primis/catalog/pcatalog/phmisweb.ppt).

7.    **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094.
The examiner can normally be reached on 10 am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the
organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published applications
may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
applications is available through Private PAIR only. For more information about the PAIR
system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR
system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER